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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,076	10/18/2000	Corey Young	MCP-207	3762

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EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,076

Applicant(s)

YOUNG ET AL.

Examiner

James H Blackwell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-10 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-10 and 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Amendment received 10/14/04.

Specification

The disclosure is objected to because of the following informalities: The first two paragraphs in the background section are repeated.

Appropriate correction is required.

The abstract of the disclosure is objected to because it exceeds 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-23 are rejected because of inappropriate use of Trademark names.

Applicant is referred to MPEP, Section 2173.05(u), which is listed below:

2173.05(u) Trademarks or Trade Names in a Claim

The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112 [\[http://www.uspto.gov/web/offices/pac/mpep/documents/appxl_35_U_S_C_112.htm\]](http://www.uspto.gov/web/offices/pac/mpep/documents/appxl_35_U_S_C_112.htm), second paragraph, but the claim should be carefully analyzed to determine how the mark or name is used in the claim. It is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. See definitions of trademark and trade name in MPEP § 608.01(v) [\[http://www.uspto.gov/web/offices/pac/mpep/documents/0600_608_01_v.htm\]](http://www.uspto.gov/web/offices/pac/mpep/documents/0600_608_01_v.htm). A list of some trademarks is found in Appendix I.

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112 [\[http://www.uspto.gov/web/offices/pac/mpep/documents/appxl_35_U_S_C_112.htm\]](http://www.uspto.gov/web/offices/pac/mpep/documents/appxl_35_U_S_C_112.htm), second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

If a trademark or trade name appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed. Does its presence in the claim cause confusion as to the

scope of the claim? If so, the claim should be rejected under 35 U.S.C. 112
<http://www.uspto.gov/web/offices/pac/mpep/documents/appxl_35_U_S_C_112.htm>, second paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 10, 19, and 21-23 remain and are rejected under 35 U.S.C. 103(a) as being unpatentable over Hackbarth (Helge Hackbarth, "Tiffy View Java Edition", Copyright 1998, downloaded from <http://web.archive.org/web/19991106083855/http://www.tiffy.de/tiffye/Tiffy.html>) in view of Microsoft Press ("Microsoft Press Computer Dictionary, 3rd Edition", Copyright 1997 Microsoft Press).

In regard to independent Claim 5, Hackbarth teaches a platform independent application (written in Java) to view and print images of the following formats: TIFF, BMP, GIF, JPG, and PNG (called Tiffy View). Additionally, Hackbarth teaches that it is usable as a standalone application or, alternatively the program can be run as a Java applet in any Java capable web browser to extend standard internet/intranet technology with a powerful component for electronic document management (see page 1). The figure located at the top of Page 2 of Hackbarth depicts the application in a Preview mode showing in the left-hand window a plurality of files as well as the file Messen.jpg

being highlighted for viewing in the right-hand window (see top Fig., p. 2; compare with Claim 5, “... ***(a) managing a plurality of data files with a host application, the host application supporting applet execution; (b) selecting a data file from a plurality of data files***”). Hackbarth does not specifically teach *(c) analyzing the data file for the presence of data of a first type and a second type*. However, it would have been obvious to one of ordinary skill in the art at the time of invention because such an action typically occurs in reading files having plural types of data. The benefit would have been to determine the file type and to be able to apply the necessary code steps to read and load the file. Hackbarth does not specifically teach *(d) processing data of the first type through a first applet and data of the second type through the second applet*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to read and extract the two file types using distinct coding portions, whether those coding portions are separate programs (applets), or part of a larger single program (applet or standalone application) because it is well known in the programming art to do so. In addition, Microsoft Press defines an applet as a small piece of code that can be transported over the Internet and executed on the recipient's machine. The term is especially used to refer to such programs as they are embedded in line as objects in HTML documents on the World Wide Web (see p. 27). The benefit of an applet being small allows it to download to the client more quickly, taking less storage space, and likely requiring smaller processing resources. Hackbarth does not specifically teach *(e) merging and formatting the processed first and second data within the host application*. However, it would have been obvious to one of ordinary skill in the art at the time of

invention to assume that this would have occurred because it is what one would have expected as part of the viewer programming as a necessary step to produce a display of the file contents. Hackbarth does teach displaying the file contents (see Figs. Pp. 1-3; compare with Claim 5, “... **(f) displaying the merged and formatted processed first and second data**”).

In regard to dependent Claim 10, Hackbarth teaches that Tiffy View can be used as an applet from an HTML web page. On the client side only a Java capable web browser like Netscape Navigator (version 3 or higher), Microsoft Internet Explorer (version 3.02 or higher) (see p. 4, 2nd paragraph; compare with Claim 10, “... **the host application comprises a hypertext browser**”).

In regard to dependent Claim 19, Hackbarth teaches displaying a list of data files (p. 2 of 5, top figure) so that a user can select from the list a file to open. Compare with Claim 19, “... **step (b) comprises: displaying a list of the plurality of data files; and enabling a user to select the data file from the displayed list**”.

In regard to dependent Claim 21, neither Hackbarth nor Microsoft Press specifically teaches that *the host application includes at least one Windows Visual Basic (VBX) control, wherein step (f) comprises: displaying the merged and formatted process first and second data using the at least one VBX control*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a VBX control as it is a notoriously well known mechanism to use in authoring graphical user interface (GUI) software.

In regard to dependent Claim 22, neither Hackbarth nor Microsoft Press specifically teaches that *the at least one VBX control includes an Accusoft ImageGEAR product control, wherein the first data type is a graphics data type, wherein step (1) comprises: displaying the graphics data type using the Accusoft ImageGEAR product control*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use the Accusoft ImageGEAR product control in concert with the VBX control, as it is a notoriously well known mechanism to use in authoring graphical user interface (GUI) software, especially as a component for the display of graphics data.

In regard to dependent Claim 23, neither Hackbarth nor Microsoft Press specifically teaches that *the at least one VBX control includes a BennetTec AllText product control, wherein the second data type is a text data type, wherein step (1) comprises: displaying the text data type using the BennetTec AllText product control*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use the BennetTec AllText product control in concert with the VBX control, as it is a notoriously well known mechanism to use in authoring graphical user interface (GUI) software, especially as a component for the display of text data.

Claims 6-9, and 14-18, and 24 remain and are rejected under 35 U.S.C. 103(a) as being unpatentable over Hackbarth in view of Microsoft Press and in further view of

Adobe ("TIFF, Revision 6.0 Specification", Copyright 06/03/1992, Adobe Developers Association).

In regard to dependent Claim 6, Hackbarth fails to teach that *the first data type is a graphics type and a second data type is a text data type*. However, Adobe teaches the TIFF 6.0 file format standard containing a header portion and a tag portion (both text), and a portion for the graphics file (specifically a Bilevel image) (see p. 20). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hackbarth, Microsoft Press, and Adobe, because they all describe aspects of manipulating mixed content files with the goal to load and display such files in an efficient and convenient manner.

In regard to dependent Claim 7, Hackbarth teaches that the applet can read Tagged Image File Format (TIFF) files that contain as part of their content Tags (see p. 1; compare with Claim 7, "... ***the data file comprises a tagged format***").

In regard to dependent Claim 8, Hackbarth fails to teach that *the first data type comprises a compressed format image*. However, Adobe teaches TIFF version 6.0 standard for storing images. One feature of the TIFF format is its ability to accept multiple types of compression schemes for the images (see pp. 30-31). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hackbarth, Microsoft Press, and Adobe, because they all describe aspects of manipulating mixed content files with the goal to load and display such files in an efficient and convenient manner.

In regard to dependent Claim 9, Hackbarth fails to teach that *the data file comprises: a header portion containing an index portion*. However, Adobe teaches a header portion containing an offset location (index) for the first IFD, a tag portion containing an offset location (index) for the next IFD. Both of these positions containing the offset location are at the end of the header and tagged portions respectively (see table p. 20). Hackbarth also fails to teach that *a first data type located near a terminus of the data file at a starting location referenced by the index portion*. However, Adobe teaches an Image Data portion with a starting location near the end of the file, with the end of the Image Data portion at the end of the TIFF file. The index identifying the location of the Image Data portion lies at the end of the regular tagged portion (see table p. 20). Hackbarth also fails to teach *a second data type located between the header and the first data type, having an end of file marker at its terminus*. However, Adobe teaches that the tagged portion (containing text) is located between the header portion and the Image Data portion (see table p. 20). Adobe does not teach that *an end of file marker exists at the end of the second data type*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to place an end of file marker at the end of any of the portions contained in the TIFF file format because it was common practice to do so, especially when similar files with mixed text and binary contents were written to 9-track tape or other linear fashion. The benefit would have been to identify different portions of the file, as well as to identify the end of a file.

In regard to independent Claim 14, Hackbarth teaches that TIFF View can be used as an applet within a web page on a web browser where files can be read and

data extracted (see p. 5). Hackbarth does not specifically teach *using separate applets to read and extract both a graphics type and a text data type in the same file*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to read and extract the two file types using distinct coding portions, whether those coding portions are separate programs (applets), or part of a larger single program (applet or standalone application) because it is well known in the programming art to do so.

Microsoft Press defines an applet as a small piece of code that can be transported over the Internet and executed on the recipient's machine. The term is especially used to refer to such programs as they are embedded in line as objects in HTML documents on the World Wide Web (see p. 27). The benefit of an applet being small allows it to download to the client more quickly, taking less storage space, and likely requiring smaller processing resources. Hackbarth fails to teach that *the data file includes an index portion in a header pointing to the first data type, and the second data type resides between the header and the first data type, having an end of file marker at a terminus thereof*. However, Adobe teaches a header portion containing an offset location (index) for the first IFD, a tag portion containing an offset location (index) for the next IFD. Both of these positions containing the offset location are at the end of the header and tagged portions respectively. Adobe also teaches an Image Data portion with a starting location near the end of the file, with the end of the Image Data portion at the end of the TIFF file. The index identifying the location of the Image Data portion lies at the end of the regular tagged portion. Adobe also teaches that the tagged portion (containing text) is located between the header portion and the Image Data portion (see

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table p. 20). Adobe does not teach that *an end of file marker exists at the end of the second data type*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to place an end of file marker at the end of any of the portions contained in the TIFF file format because it was common practice to do so, especially when similar files with mixed text and binary contents were written to 9 track tape or other linear fashion. The benefit would have been to identify different portions of the file, as well as to identify the end of a file.

In regard to dependent Claim 15, Claim 15 reflects the method of processing a data file having two different data types as Claimed in Claim 14, and is rejected along the same rationale.

In regard to dependent Claim 16, Hackbarth teaches a platform independent application (written in Java) to view and print images of the following formats: TIFF, BMP, GIF, JPG, and PNG (called Tiffy View). Additionally, Hackbarth teaches that it is usable as a standalone application or, alternatively the program can be run as a Java applet in any Java capable web browser to extend standard internet/intranet technology with a powerful component for electronic document management (see page 1).

Hackbarth does not specifically teach *invoking the first and second applets for interpreting the composite data*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to assume that the applet was invoked by downloading the file from the browser, as this is its function as a viewer for various file types including TIFF. Reading the file using two separate applets, or one applet with two classes would not matter. The benefit would have been that an applet was

performing the reading and viewing of the file assuming the graphics viewer was browser-based.

In regard to dependent Claim 17, Hackbarth fails to teach that *the first data type is a graphics type and a second data type is a text data type*. However, Adobe teaches the TIFF 6.0 file format standard which depicts a header portion, a tag portion, and a portion for the graphics file (see table p. 20). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hackbarth, Microsoft Press, and Adobe, because all are related to TIFF format files. The benefit would have been to provide an accepted format scheme for describing mixed format files.

In regard to dependent Claim 18, Hackbarth fails to specifically teach that *the header and first data type are compatible with the Group 4 Tagged Image Format File specifications*. However, Adobe teaches the format of a TIFF version. 6.0 file (specifically a bilevel graphics file) (see table p. 20). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hackbarth, Microsoft Press, and Adobe, because all are related to TIFF format files. The benefit would have been to provide an accepted format scheme for describing mixed format files.

In regard to dependent Claim 24, Hackbarth teaches displaying a list of data files (p. 2 of 5, top figure) so that a user can select from the list a file to open. Compare with Claim 24, **"... displaying a list of data files at the object browser; and enabling a user to select the data file from the displayed list"**.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hackbarth in view of Microsoft Press and in further view of Lynch et al. (hereinafter Lynch, U.S. Patent No. 5,689,669).

In regard to dependent Claim 20 neither Hackbarth nor Microsoft Press specifically teach that *said enabling step comprises: enabling the user to sort the displayed list*. However, Lynch teaches a Graphical User Interface (GUI) that displays a list of files. These files can be sorted by clicking a button (516) (Fig. 15). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hackbarth, Microsoft Press, and Lynch as Hackbarth and Lynch describe a user interface that, among other things, displays file listings. Lynch allows for sorting of the file listing, providing the benefit of locating files more readily.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hackbarth in view of Microsoft Press and in further view of Adobe and in further view of Lynch.

In regard to dependent Claim 25, neither Hackbarth, Microsoft Press nor Adobe specifically teaches that *said enabling step comprises: enabling a user to sort the displayed list*. However, Lynch teaches a Graphical User Interface (GUI) that displays a list of files. These files can be sorted by clicking a button (516) (Fig. 15). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hackbarth, Microsoft Press, Adobe, and Lynch as Hackbarth and Lynch

describe a user interface that, among other things, displays file listings. Lynch allows for sorting of the file listing, providing the benefit of locating files more readily.

Response to Arguments

Applicant's arguments filed 10/14/04 have been fully considered but they are not persuasive. Applicant argues that with respect to Claim 5 (and similarly Claim 14), the prior art of Hackbarth does not teach step (d) processing data of the first type through a first applet and data of the second type through a second applet. The examiner has acknowledged this in the previous office action. However, the examiner has argued that it would have been just as obvious to combine first and second applets into a larger applet to perform the same function. The examiner sees no non-obvious advantage to having two applets rather than a single combined applet performing the same function. The examiner also does not agree that the Hackbarth reference teaches away from the presently claimed embodiments of the present invention as having the ability to read multiple formats (e.g. "TIFF, BMP, GIF, JPG, PNG") is not relevant since presumably the applicant's invention would be capable of reading multiple file formats (versus multiple file types within a file). At least one of these file types (TIFF) contains a header portion and a binary compressed portion (see Adobe, TIFF specification reference).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
02/15/05


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER